IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Paul A. Stucky
Serial Number:	10/598,044
Filed:	08/16/2006
Group Art Unit:	2837
Examiner:	Chan, Kawing
Confirmation No.:	9489
Title:	ELECTRICAL SIGNAL APPLICATION STRATEGIES FOR MONITORING A CONDITION OF AN ELEVATOR LOAD BEARING MEMBER

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests Pre-Appeal Brief Review of the rejections in the Final Office Action mailed on March 16, 2011 because there is no *prima facie* case of obviousness.

The rejection of claims 1, 3, 8, 9, 15-17 and 20 under 35 U.S.C. §103 should be withdrawn.

Applicant respectfully submits that there is no *prima facie* case of obviousness. The Examiner proposes to modify the *Clarke* reference with teachings from the *Crick* reference. There must be a legally sufficient reason for such a modification. When the teachings of the secondary reference do not provide any benefit in the context of a primary reference, that reason

is missing and there is no *prima facie* case of obviousness. The proposed combination cannot be made. In terms of the recent Examiner Guidelines regarding the obviousness inquiry, there is no predictable result.

In this instance, the teachings of the *Crick* reference do not provide any benefit in the context of the *Clarke* reference because the condition being addressed by the *Crick* reference will not occur in the *Clarke* reference. The *Crick* reference is directed to locating a fault that is a short between two conductors. There will not be any such condition in the *Clarke* reference. That reference teaches that the tensile members 10 are separated by the elastomeric body because the "tensile cords 10 are embedded in elastomeric material 11 in such a way so as to prevent contact between adjacent cords 10 along the length of the belt." (Paragraph 15, lines 3-6) Therefore, the elastomeric material 11 in the *Clarke* reference prevents any contact between adjacent cords 10 along the length of the belt. In other words, it is impossible for there to be a short between them along their length.

Additionally, identifying a short in the *Clarke* reference would not provide any useful information because of the way that the ends of the cords 10 are electrically connected to each other. Each end of the tensile cords is connected to the end of the next cord to form a series circuit (paragraph 16, lines 1-2). Given that the tensile cords in the *Clarke* reference are already connected to each other at the ends, there is no concern with identifying a short between them because they are already connected to each other.

The techniques disclosed in the *Crick* reference are for locating a short between two conductors. Given that there is no need for any such location technique in the *Clarke* reference, the proposed modification does not provide any benefit and, therefore, the legally required reason for making the modification is missing. There is no *prima facie* case of obviousness.

Further, the *Clarke* reference is concerned with noticing changes in resistance associated with changes in strain on the tensile cords of *Clarke's* belt. The *Clarke* reference relies upon connecting the different tensile cords together to form a series circuit. A short between any of those tensile cords (however extremely unlikely because of the elastomeric material between them) will not have any effect on the tension on those cords and will not affect the resistance. Further, any short in the *Clarke* reference will not change the ability of the *Clarke* reference to achieve its intended result of monitoring resistance.

Lastly, there would be no benefit to locating a short in the *Clarke* reference. That is the entire purpose of the teachings of the *Crick* reference. Locating a short in the belt of the *Clarke* reference does not provide any benefit. If the resistance measurements obtained in the *Clarke* reference indicate that something should be done regarding the condition of the belt, the entire belt is going to be replaced. There is no need to identify the location of a short using the techniques of the *Crick* reference.

The Examiner cannot divorce the duty cycle teachings of the *Crick* reference from the remainder of that reference for purposes of attempting to cobble together a *prima facie* case of obviousness. The entire context of the reference must be considered in order to determine what that reference teaches or suggests to one of skill in the art. The *Crick* reference teaches how to identify and locate shorts between conductors. There is no use for identifying a short in the *Clarke* reference. It follows that the teachings of the *Crick* reference do not have any relevance or usefulness in the context of the *Clark* reference. There is no benefit from making the proposed modification. Therefore, there is no predictable result and the combination cannot be made. There is no *prima facie* case of obviousness and the rejection should be withdrawn.

The rejection of claims 2, 7, 10, 14 and 18 under 35 U.S.C. §103 should be withdrawn.

Applicant respectfully traverses this rejection for the same reasons given above. The base combination of the *Clarke* and *Crick* reference cannot be made. Therefore, there is no *prima facie* case of obviousness regardless of what the *Robar* reference actually teaches.

Further, Applicant respectfully submits that the *Clarke* and *Crick* references teach away from the Examiner's proposed modification of the improper base combination. The *Clarke* reference teaches that the tensile cords are connected together in series. Therefore, a signal applied to one of the tensile cords is going to be applied to all of them. This feature of the *Clarke* reference teaches away from the Examiner's proposed modification of applying the signal to only one of the tension members at a time.

Further, the *Crick* reference ***requires*** that two conductors (between which there is a short that the *Crick* reference is trying to locate) both receive the current at the same time. The arc that is produced in the *Crick* reference can only be produced if current is supplied to both conductors at the same time.

Given that the *Clarke* and *Crick* references both teach away from the Examiner's proposed modification, the legally required reason for making it is missing and there is no *prima facie* case of obviousness.

Additionally, it is not possible to modify the teachings from the *Crick* reference in a manner that would apply current to only one of the two conductors because that would entirely change the principle of operation of that reference and would defeat its ability to achieve its intended result. Without current in both conductors at the same time, the technique of the *Crick* reference will not work at all. Such a modification cannot be made for purposes of attempting to

manufacture a *prima facie* case of obviousness. MPEP 2143.01(V) and (VI) are instructive on this point. There is no *prima facie* case of obviousness and the rejection should be withdrawn.

The rejection of claims 4, 5, 11, 12 and 19 under 35 U.S.C. §103 should be withdrawn.

As explained above, the proposed base combination of the *Clarke* and *Crick* references cannot be made. There is no predictable result. The proposed addition of teachings from the *Brucken* reference does not remedy that defect and there still is no *prima facie* case of obviousness. The rejection should be withdrawn.

Respectfully submitted,

CARLSON, GASKEY & OLDS

By: _____

David J. Gaskey, Reg. No. 37,139
400 W. Maple Rd., Ste. 350
Birmingham, MI 48009
(248) 988-8360

Dated: May 18, 2011

N:\Clients\OTIS ELEVATOR\IP00122 PUS1\PATENT\Pre-appeal brief request for review 5-12-11.doc